

### **REMARKS**

This responds to the Office Action mailed on May 3, 2006, and the references cited therewith.

Claim 20 is amended, no claims are canceled herein, and no claims are added; as a result, claims 10-21, 23-26, and 29-32 remain pending in this application. No new matter has been added.

#### **§ 103 Rejection of the Claims**

Claims 10-17, 20, 21, and 29-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Franck et al (U.S.6,529,765) in view of Truwit (U.S. 6,206,890). Applicant respectfully traverses the rejection for at least the following reasons.

The rejection states that Franck discloses a local adjustment device and an actuator coupled to the local adjustment device. The rejection admits that Franck does not disclose a remote actuator spaced apart from the local adjustment device to locate the actuator outside an imaging region of the imaging device while the local adjustment is within the imaging region of the imaging device. The rejection further states that “Truwit shows in Figures 30-32 a mechanical remote actuation and control device 3000.” The Response to Applicant’s prior arguments regarding the term “detachable” states that the “actuator guidance 240 in Truwit is attached by clamp 1200 to surgical instrument 1400 (col. 21, lines 57-63). Thus clamping is interpreted as attachable and hence detachable.”

Truwit appears to show a “remote actuation and control device 3000” (column 14, lines 26-27). Truwit also appears to show a linear system for inserting or introducing a surgical instrument 1400. However, Applicant is unable to find in Truwit a control module in remote communication with the actuator and in communication with the imaging device, the control module aligning the insertion axis with the target location. Applicant is further unable to find in Truwit a multi-axis local adjustment device with an actuator remotely and detachably coupled to the local adjustment device.

The pending office action argues that “it would have been obvious to one having ordinary skill in the art at the time of the invention was made to apply the teachings of Truwit’s remote actuator with Franck et al’s device as described above.” However, Applicant is unable to find

any teachings in the references themselves, or any motivation to combine the references as outlined in the present Office Action regarding claim 10. Regarding Figure 30, Truwit recites that “a surgeon or physician can then manipulate the first trajectory guide 3001 that is within the scanning environment by manipulating the second trajectory guide 3002 that is outside the scanning environment” (Col. 14, lines 49-53). This embodiment of Truwit and the embodiment discussed in Figure 14 appear to teach a surgeon’s presence outside an MR tube, yet in close proximity to a patient.

Franck recites that “The surgeon adjusts the manipulator fixture which provides control signals to a teleoperator application 2740 executing on workstation 580. Teleoperator application 2740 converts these control signal to motor control signals for guidance fixture 2600 and transmits the motor control signals to the guidance fixture” (Col. 24, lines 33-38). Embodiments of Franck appear to contemplate remote actuation. However Applicant is unable to find any motivation in Franck to separate the actuator apart from the local adjustment device to enable location of the actuator outside an imaging region of the imaging device while the local adjustment device is within the imaging region, and to additionally couple a control module in remote communication with the actuator and in communication with the imaging device.

Applicant’s specification discusses one possible advantage of such a combination on page 10, line 26 to page 11 line 7. Regarding detachable actuators, this section states that a more expensive actuator “can be reused, potentially without intensive sterilization, and the trajectory device can be more easily sterilized, or alternatively, disposed of after each procedure.” However, absent any impermissible hindsight, Applicant is unable to find a motivation to combine the references as suggested in the pending Office Action. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

In contrast, claim 10 includes an actuator detachably coupled to the local adjustment device, wherein the actuator is spaced apart from the local adjustment device to enable location of the actuator outside an imaging region of the imaging device while the local adjustment device is within the imaging region of the imaging device, and a control module in remote

communication with the actuator and in communication with the imaging device, the control module aligning the insertion axis with the target location.

Further in contrast, claim 20 as amended includes attaching a multi-axis local adjustment device to the adjustable joint, coupling an actuator to the local adjustment device, wherein coupling the actuator to the local adjustment device includes remotely coupling the actuator to the local adjustment device, remotely actuating the actuator to adjust alignment of the insertion axis within the range of motion, and detaching the actuator from the local adjustment device upon completion of a procedure. Among other distinguishing features, Applicant is unable to find in Truwit, Franck or their combination, a multi-axis local adjustment device with a detachable actuator as recited in claim 20.

Because the cited references, either alone or in combination, do not show every element of Applicant's independent claims, a 35 USC § 103(a) rejection is not supported by the references. Reconsideration and withdrawal of the rejection are respectfully requested with respect to Applicant's independent claims 10 and 20. Additionally, reconsideration and withdrawal of the rejection are respectfully requested with respect to the remaining claims that depend therefrom as depending on allowable base claims.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6944 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

GERALD W. MILLS ET AL.

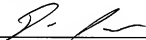
By their Representatives,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 5th day of September, 2006.

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